



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,535	02/16/2001	Norman H. Margolus	11656-002001	5190

26161 7590 04/07/2003

FISH & RICHARDSON PC  
225 FRANKLIN ST  
BOSTON, MA 02110

EXAMINER

PHAM, HUNG Q

ART UNIT	PAPER NUMBER
----------	--------------

2172

DATE MAILED: 04/07/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/785,535

Applicant(s)

MARGOLUS ET AL.

Examiner

HUNG Q PHAM

Art Unit

2172

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-153 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-153 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-97, drawn to a method of encrypting the data using a key from the content of data item to store the data item at a location associated with a digital fingerprint, classified in class 713, subclass 150.
  - II. Claims 98-114, 117-119, drawn to a method for storing data item by associating data item with each of access authorization credentials, classified in class 707, subclass 9.
  - III. Claims 115-116, drawn to a method for transferring data item using a low-speed connection from the client to the repository, which connected to the network over a higher speed than the client, the data item is executing by an application for returning to the client across the lower speed connection, classified in class 709, subclass 233.
  - IV. Claims 120-121, drawn to a method for data transfer regulating by transmitting the fragment to repository after determining, comparing a digital fingerprint of each fragment with digital fingerprints of data item in the repository, classified in class 709, subclass 232.
  - V. Claims 122-127, drawn to a method for rearranging a sequence of bit string by dividing the bit string into segments and transforming disjoint

groups of homologous bits using a state permutation operation, classified in class 712, subclass 300.

- VI. Claims 128-153, drawn to a method for selling a backup services by accepting an unlimited amount of backup data, storing the data for free or at a charge to cover the cost of operating the backup services and charging a fee greater than the fee charged for accepting the data for recovery the data from the repositories, classified in class 705, subclass 404.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I-VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. For example, Group I is a method for encrypting the data using a key from the content of data item to store the data item at a location associated with a digital fingerprint, Group II is a method for storing data item by associating data item with each of access authorization credentials, Group III is a method for transferring data item using a low-speed connection from the client to the repository, which connected to the network over a higher speed than the client, the data item is executing by an application for returning to the client across the lower speed connection, Group IV is a method for rearranging a sequence of bit string by dividing the bit string into segments and transforming disjoint groups of homologous bits using a state permutation

Art Unit: 2172

operation, Group V is a method for selling a backup services by accepting an unlimited amount of backup data, storing the data for free or at a charge to cover the cost of operating the backup services and charging a fee greater than the fee charged for accepting the data for recovery the data from the repositories. See MPEP 806.05(d).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. Applicants are advised that the reply to this requirement to be completed must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicants is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Contact Information***

Art Unit: 2172

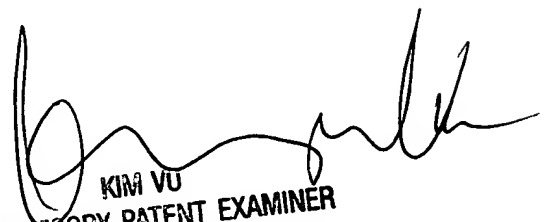
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Pham whose telephone number is 703-605 4242.

The examiner can normally be reached on Monday-Friday, 7:00 Am - 3:30 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, VU, KIM YEN can be reached on 703-305 4393. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746 7239 for regular communications and 703-746 7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305 3900.

Examiner: Hung Pham  
March 24, 2003

  
KIM VU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100